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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,064	04/13/2001	Giovanni Giuffrida	HRL065	3890
28848	7590	10/06/2006	EXAMINER	
TOPE-MCKAY & ASSOCIATES 23852 PACIFIC COAST HIGHWAY #311 MALIBU, CA 90265			ABEL JALIL, NEVEEN	
			ART UNIT	PAPER NUMBER
			2165	

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,064

Applicant(s)

GIUFFRIDA ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/5/06 & 3/6/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. The Requests for Reconsideration filed on July 5, 2006 and March 6, 2006 have been received and entered. Claims 1-16 are pending.
2. Applicant's response has overcome the rejections under 35 USC 101.

Claim Objections

3. Claims 1-16 are objected to because of the following informalities:

Independent claim 1 is directed to "An apparatus for automatically" in the preamble, later on, dependent claims 2-8, introduce the statement of "An apparatus according to claim 1" making it vague and unclear to the Examiner if a new method separate from the proceeding one, takes place, after the initial process or if the claims are meant to be independent claims and therefore should be written as such. Claims 2-8 lack sufficient antecedent basis.

Dependent claims should be constructed to be preformed the same method introduced in the Independent claim of which they dependent (i.e. The apparatus of claim 1). Correction is required.

Claims 10-16 carry the same deficiency.

A semicolon is missing in claim 1, line 3, after the recitation of "wherein" to clearly distinguish the preamble and the body of the claim.

Claims 1, and 9, recite “using” constitute intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably; therefore, carry no patentable weight. Intended use recitation is the claims never has to occur. Claims should be amended to recite more firm and positive language (i.e. “based on”, “of”, “is”, “to”, “wherein”, “employing”, or “providing”). Appropriate correction is required.

Claims 5, and 13, recite “can be” is indirect, suggest optionally, and passive which renders any recitation claimed after not be given patentable weight. Appropriate correction is required. Claims should be amended to recite “is” or “will be”. Correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 4, the recitation of “is further configured” renders the claim to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Examiner what the first processing element was initially configured to perform or how else is the first processing element can be configured. Claim should be amended to recite, “is configured” deleting the “further”.

In claim 1, line 12, the recitation of “to also provide” renders the claim to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Examiner how else is the database configured to do or what other steps is the database providing? Claim should be amended to recite “database is configured” deleting the “also”.

Claim 1, line 9, recites the limitation “extract predetermined information” then the claim further recites “extracting metadata” it is unclear to the Examiner what the difference between the two claimed limitations if any exist and if there’s a clear and precise difference then it should be disclosed in the claim thereby renders the claim to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner does not find a clear definition of the “extracted predetermined information” in the specification. Claims needed to be amended to show this distinct difference.

There appears to be no nexus between the intended use of the preamble “for automatically extracting metadata” and the body of the claims in order to realize the preamble.

In claims 1, and 9, the body of the claim is only directed to “extracting metadata” and not to “automatically” provide this functionality as suggested by the preamble. The body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention. See MPEP 2111.02 [II].

Furthermore, it is unclear to the Examiner how the two sets of extracted information/metadata are linked together in order to perform the steps of the claimed invention. If there's a clear and precise difference then it should be disclosed in the claim. In the Specification a definition of "extracting predetermined information" is merely stated as "extracting the desired information" (See specification paragraph 0063) and only stated as such in paragraph 0069 under "another embodiment" of the invention and not stated in the overall all invention or the preferred embodiment.

Independent Claim 9 carry the same deficiency.

Claims 2-8, and 10-16, are dependent on Independent claims 1, and 9, respectively and therefore carry the same deficiency.

6. Regarding claims 2 and 10, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Claims should be amended to recite more definite language i.e. substantially or for the clarity and the precision of the language can be improved by the deletion of the phrase "such as" in the claim

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Mahoney et al. (U.S. Patent No. 5,999,664).

As to claim 1, Mahoney et al. discloses an apparatus for automatically extracting metadata from electronic documents comprising a first processing element, a second processing element, a reasoning element, and a database, wherein,

i) said first processing element is further configured to convert electronic documents into files (See column 7, lines 43-53);

ii) said first processing element is configured to provide the files to a second processing element (See column 5, lines 23-36);

iii) said second processing element is configured to receive said files and extract predetermined information (See column 4, lines 46-58, also see column 8, lines 10-24);

iv) said second processing element is further configured to provide said extracted predetermined information to said reasoning element (See column 8, lines 41-51);

v) said database is configured to also provide input to said reasoning element (See column 8, lines 53-65);

vi) said reasoning element is configured to use a set of rules to extract metadata from the files (See column 4, lines 46-58, also see column 9, lines 19-31, also see column 10, Table 1, shows "Rules");

vii) reasoning element provides an output of metadata (See column 9, lines 32-51).

As to claims 2, and 10, Mahoney et al. discloses an apparatus for automatically extracting metadata from electronic documents, wherein said files are substantially format invariant data files such as Postscript files (See column 14, lines 11-44, column 1, lines 34-37, prior art).

As to claims 3, and 11, Mahoney et al. discloses wherein said predetermined information is substantially spatial layout facts (See column 5, lines 46-61).

As to claims 6, and 14, Mahoney et al. discloses wherein said metadata is substantially comprised of title, author, affiliation, author affiliation, and table of contents (See column 4, lines 47-56, and see column 9, lines 23-31).

As to claims 4, and 12, Mahoney et al. discloses wherein the second processing element and said database simultaneously input to the reasoning element (See column 2, lines 4-16).

As to claims 5, and 13, Mahoney et al. discloses wherein said set of rules can be updated (See column 2, lines 17-36, wherein set of rules” reads on genre or “predefined form”, also see Figure 9, 990, Arrange Summarized Documents According To Display Profile).

As to claims 7, and 15, Mahoney et al. discloses wherein said metadata is provided to a user interface (See Figure 7).

As to claims 8, and 16, Mahoney et al. discloses wherein said metadata is provided to a storage medium (See Figure 2).

As to claim 9, Mahoney et al. discloses a method for automatically extracting metadata from electronic documents comprising a first processing element, a second processing element, a reasoning element, and a database, and comprising the steps of:

- i) using said first processing element to convert electronic documents into files (See column 7, lines 43-53);
- ii) further using said first processing element to provide the files to a second processing element (See column 5, lines 23-36);
- iii) using said second processing element to receive said files and extract predetermined information (See column 4, lines 46-58, also see column 8, lines 10-24);
- iv) further using second processing element to provide said extracted predetermined information to said reasoning element (See column 8, lines 41-51);
- v) using said database to provide input to said reasoning element (See column 8, lines 53-65);
- vi) using a set of rules in said reasoning element to extract metadata from the files (See column 4, lines 46-58, also see column 9, lines 19-31);
- vii) providing an output of metadata from said reasoning element (See column 9, lines 32-51).

Response to Arguments

9. Applicant's arguments filed on July 5, 2006 and March 6, 2006 have been fully considered but they are not persuasive.

In response to Applicant's argument that "further configured" showing the degree the processing element is configured is proper" is acknowledged but not deemed to be persuasive.

The Examiner contends that there is no showing of an initial configuration in order for the word "further" to be grammatically correct English in light of the claim language and in order to be given clear meaning since it suggest the first processing element is missing element/step that must have been first configured with in order to have a "further configuration" suggest by the claim language. There can be no additional "degree" attributed to the first processing element without any prior basis. A simple deletion of the word "further" provides clarity to the claims.

In response to Applicant's argument that "to also provide" is clear distinction in the claims" is acknowledged but not deemed to be persuasive.

In this case as clearly stated by the Applicant's remarks on page 6, the "second processing element is the one providing the input" thus making it difficult to understand the role that the database is contributing. It is not clear from the claim language that the "database" is providing input in addition to the second processing means. It is initially understood from the claim language that the database has provided initial input and now is providing more. Which incorrect. Clarification to the claim language would be helpful.

In response to Applicant's argument that "the distinction is clear in the claims between the extracted predetermined information and the metadata" is acknowledged but not deemed to be persuasive.

In claim 1, element (iii) Is the "extract predetermined information" being done from the "files"? If so clarification is needed in the claim to that effect. Is the predetermined information different from the metadata? If so, that distinction is unclear in the claims since both can be the same information in light of Applicant's remarks on page 7. If such distinction was pertinent to the claim language it should be made clear in the claims.

The preamble is directed to "*automatically* extracting metadata" (emphasis added) which is never stated in the body of claim.

Applicant's argument on page 8, stating that the "extracted predetermined information" is used to extract the "metadata" is acknowledged but clearly not stated or presented as such in the Independent claims. There appears to be no relationship between the two extraction steps. They are clearly taking place in different hardware elements without any matching or mapping between the two.

Applicant's arguments filed on March 6, 2006 regarding the "such as" 112, second rejection is addressed above and furthermore it appears as an example presented in the claims and not as the Applicant has described it to be. The Applicant's remarks provides it to be equivalent to "substantially" if that's the case, such language should be used instead to be more clear and precise. See MPEP 2173.02 and 2173.03.

In response to Applicant's argument that "the present invention automatically extracts metadata from electronic documents in contrast to Mahoney et al." is acknowledged but not deemed to be persuasive.

There is no recitation of the word "automatically" in the body of the claim as suggested by the Applicant's remarks on page 11. In fact, the addition of "automatically" would provide accuracy and clarity of the invention in light of the preamble and the arguments.

Mahoney et al.'s metadata, as taught in column 8, lines 39-51, and column 9, lines 19-31, is dynamically provided either at time prior the scanning or after and such any documents scanned falling under the rules can have its metadata automatically extracted (as argued) or just merely extracted (manually as the claim language suggests). There's no suggestion in the claims that the metadata is not provided previously by the user prior to running the current process.

In response to Applicant's request that the Examiner indicated exactly where in Mahoney et al. is the limitation "second processing element is configured to provide said extracted predetermined information to said reasoning element, and said reasoning element is configured to use a set of rules to extract metadata" is found" the request is acknowledged but not deemed to be persuasive.

The Examiner contends that Mahoney et al. in its entirety and more specifically in column 21, lines 1-17, also see column 26, lines 25-39 discloses the argued limitation wherein pattern matching and similarity features are clearly taught. The Mahoney et al. invention is directed to searching a corpus of document images specified document layout components,

which are essentially specified feature information (Data that is used to describe other data= metadata) and spatial rules sought after, for match.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neveen Abel-Jalil
October 2, 2006



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER